

**REMARKS**

The Examiner is thanked for the due consideration given the application.

Claims 19-28, 34-63 and 66-75 are pending in the application. Claim 19 has been amended to generally incorporate subject matter found in claims 39 and 50.

No new matter is believed to be added to the application by this amendment.

**Rejection Under 35 USC §112, First Paragraph**

Claim 67 has been rejected under 35 USC §112, paragraph as failing to comply with the written description requirement. This rejection is respectfully traversed.

Claim 67 pertains to a disinfection process that entails treating with a composition of 1-(2-ethyl-hexyl)glycerol ether and at least one aromatic alcohol, and recites: "said composition not being capable of disinfecting said article absent thermochemical disinfection."

The Official Action asserts that the Examples in the specification teach that the inventive compositions "would be capable of achieving some level of disinfection at room temperature."

However, the Examples in the specification teach that there is insufficient activity at room temperature. For example, the Table for Example 2 at page 18 of the specification amply

demonstrates that the reduction factor is most likely to be zero at room temperature, but at 50 °C the reduction factors are substantial and are in the 3-5 range for most microbes.

Therefore, one would realize that the composition of the present invention is used at elevated temperatures to achieve disinfection via the thermal decomposition reaction.

Claim 67 is thus fully supported by the specification.

This rejection is believed to be overcome, and withdrawal thereof is respectfully requested.

**Rejections Under 35 USC §103(a)**

Claims 19-28, 34-36, 42-63 and 66 have been rejected under 35 U.S.C. 103(a) as being unpatentable over SAUD et al. (U.S. Publication 2004/0001797) in view of TU et al. (WO 92/09309). Claims 37-41 have been rejected under 35 U.S.C. 103(a) as being unpatentable over SAUD et al. and TU et al., as applied to claim 19 and further in view of CARTER (U.S. Patent 5,686,045). Claims 67 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over LANGFORD (U.S. Patent 5,906,802) in view of WALDMANN-LAUE et al. (U.S. Patent 5,539,001) and SAUD et al. Claims 69-75 have been rejected under 35 U.S.C. 103(a) as being unpatentable over LANGFORD, WALDMANN-LAUE et al. and SAUD et al. as applied to claim 69, and further in view of TU et al. These rejections are especially traversed.

The present invention pertains to disinfecting the surface of an article with a composition that includes

1-(2-ethyl-hexyl)glycerol ether. Independent claim 19 of the present invention sets forth a time of about 5 to 15 minutes and a temperature of from about 100 °C to 150 °C. Independent claim 19 of the present invention also sets forth that the composition is not effective to disinfect at 25 °C during the time.

SAUD et al. pertains to antimicrobial compositions for personal care products. SAUD et al. fails to disclose a method for disinfecting a surface at a temperature in the range of about 100 °C to 150 °C.

Paragraph 0035 of SAUD et al. lists 1-(2-ethyl-hexyl)glycerol ether as a "suitable nonionic agent." However, SAUD et al. fails to teach the elevated temperatures of the present invention, which are totally unsuitable for personal care products.

The Official Action by turning to SAUD et al. is thus changing the principle of operation and making these personal care products of SAUD et al. unsuitable for their intended purpose.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then

there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

TU et al. pertain to sterilization using polyepoxide-compounds in a liquid sterilant. The Official Action turns to page 7, lines 22-34 of TU et al. for teachings pertaining to elevated temperature. This passage utilized for teachings pertaining to elevated temperatures merely sets forth autoclaving conditions. TU et al. thus teach nothing pertaining to a disinfection due to the thermal decomposition of a composition containing 1-(2-ethyl-hexyl)glycerol ether.

TU et al. additionally teach a minimum contact time of 4 hours (see page 8, line 13). TU et al. fail to teach or suggest a time of about 5 to 15 minutes, such as is set forth in independent claim 19 of the present invention.

Regarding independent claim 37, the Official Action refers to CARTER for teachings pertaining to elevated pressure. However, these teachings of CARTER fail to address all the deficiencies of SAUD et al. and TU et al. in suggesting all the embodiments of claim 37, i.e., ineffectiveness at 25 °C.

Regarding independent claim 67, the Official Action combines LANGFORD with WALDMANN-LAUE et al. and SAUD et al. However, this combination fails to suggest all the embodiments of claim 67, i.e., no disinfection absent thermochemical disinfection.

The other combinations of references, utilized to rejection claims depending upon the independent claims of the present invention, fail to address the deficiencies of the applied art discussed above.

One of ordinary skill and creativity would thus fail to produce independent claims 19, 37 and 67 from a knowledge of the applied art references. A *prima facie* case of unpatentability has thus not been made. Claims depending upon claims 19, 37 or 67 are patentable for at least the above reasons.

These rejections are believed to be overcome, and withdrawal thereof is respectfully requested.

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#### **Double Patenting**

Claims 67-75 have been rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 73-81 of copending application 10/825,412. This rejection is respectfully traversed.

The Examiner is respectfully requested to forestall further action on this double patenting rejection until the issue ripens and one of the copending applications matures into an issued patent.

#### **Conclusion**

The objections are believed to have been overcome, obviated or rendered moot and no issues remain. The Examiner is

accordingly respectfully requested to place the application in condition for allowance and to issue a Notice of Allowability.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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